

Remarks

~~Claims 1-4, 6-10, 12, 15-17, 24, 28, 32 and 52-55 are pending in the subject application.~~
Applicants respectfully point out that the office action cover sheet and the office action itself state that claims 1-4, 6, 10, 12, 15-17, 24, 28, 32 and 52-55 are pending [emphasis added]. However, applicants respectfully note for the record that claims 1-4, 6-10, 12, 15-17, 24, 28, 32 and 52-55 are pending [emphasis added]. Applicants respectfully direct the Examiner's attention to the cover sheet of the prior office action which provides, inter alia, that claims 6-10 are pending. Applicants have herein amended claims 1-4, 6-10, 12, 15-17, 24, 28, 32 and 52-55. These amendments do not involve any issue of new matter. Therefore, entry of this amendment is respectfully requested. Upon entry of this amendment, claims 1-4, 6-10, 12, 15-17, 24, 28, 32 and 52-55 will still be pending.

Election of Species:

Applicants would like to point out to the Examiner that the subject matter of the pending claims has already been examined and thus, there would not any undue burden on the Examiner. *See e.g.* August 17, 1998 Office Action. Accordingly, contrary to the Examiner's position, applicants respectfully submit that the subject matter of each of the pending claims is under examination.

Provisional Double Patenting Rejection:

The Examiner provisionally rejected claims 1-4, 6-10, 12, 15-17, 24, 28, 32 and 52-55 under the judicially created doctrine of obviousness-type double patenting over U.S. Serial No. 08/643,321.

In response, applicants respectfully note that this is a provisional double patenting rejection since both the subject application and U.S. Serial No. 08/643,321 are pending. Accordingly, applicants contend that nothing is necessary at this time and that the Examiner may continue to maintain the rejection until both cases are ready to issue. *See* MPEP 804 ("The 'provisional' double patenting rejection should continue to be made by the examiner in each application as long as there are conflicting claims in more than one application unless that 'provisional' double patenting rejection is the only rejection remaining in one of the applications. If the 'provisional' double patenting rejection in one application is the only rejection remaining

in that application, the examiner should then withdraw that rejection and permit the application to issue as a patent, thereby converting the 'provisional' double patenting rejection in the other application(s) into a double patenting rejection at the time the one application issues as a patent. If the 'provisional' double patenting rejections in both applications are the only rejections remaining in those applications, the examiner should then withdraw that rejection in one of the applications (e.g., the application with the earlier filing date) and permit the application to issue as a patent. The examiner should maintain the double patenting rejection in the other application as a 'provisional' double patenting rejection which will be converted into a double patenting rejection when the one application issues as a patent.")

Rejection under 35 U.S.C. §103

The Examiner rejected claims 1-4, 6-10, 12 and 52-55 under 35 U.S.C. §103(a) as being unpatentable over Kubersampath, Watanabe and Glasscock. The Examiner also rejected claims 1-2, 15 and 16 under 35 U.S.C. §103(a) as being unpatentable over Kubersampath, Watanabe and Glasscock, and further in view of Coe, Kees-Folts and Jennerholm. The Examiner also rejected claims 1-2, 17, 24, 28 and 32 under 35 U.S.C. §103(a) as being unpatentable over Kubersampath, Watanabe and Glasscock, and further in view of Brenner.

In response, applicants respectfully traverse the Examiner's above rejection. First, applicants would like to remind the Examiner that claim 1 recites in part "[a] method of improving renal function in a mammal in, or at risk of, chronic renal failure...wherein said mammal is afflicted with a chronic renal condition characterized by the progressive loss of renal function associated with the progressive loss of functioning nephron units" and claim 2 recites in part "[a] method of delaying the need for, or reducing the frequency of, chronic dialysis treatments in a mammal in, or at risk of, chronic renal failure... wherein said mammal is afflicted with a chronic renal condition characterized by the progressive loss of renal function associated with the progressive loss of functioning nephron units." Applicants contend that the Examiner has not established a prima facie case of obvious with respect to the invention as recited in the claims. Applicants respectfully remind that Examiner one of the requirements for establishing a prima facie case of obviousness is a suggestion or motivation, either in the references themselves or in the knowledge generally available to one skilled in the art, to modify the reference or

combine the reference. *See* MPEP 2143. The Examiner must also show a reasonable expectation of success. *See* MPEP 2143.

The Examiner has not provided any rationale for why the combination of the cited references render obvious either (1) a method of improving renal function in a mammal in or at risk of chronic renal failure, wherein the mammal is afflicted with a chronic renal condition characterized by the progressive loss of renal function associated with the progressive loss of functioning nephron units, or (2) a method of delaying the need for or reducing the frequency of chronic dialysis treatments in a mammal in or at risk of chronic renal failure, wherein the mammal is afflicted with a chronic renal condition characterized by the progressive loss of renal function associated with the progressive loss of functioning nephron units. The Examiner has cited Kuberasampath, apparently for the Examiner alleges it teaches regarding the use of OP-1 to treating a chronic inflammatory disease.

First applicants would like to note for the record that the Examiner has conceded several things: (1) "Kuberasampath is silent with respect to the administration of OP-1 to a mammal afflicted with chronic diabetic nephropathy;" (2) Watanabe does "not teach the administration of OP-1 to a mammal afflicted with chronic diabetic nephropathy;" and (3) Glossock does "not teach the administration of OP-1 to a mammal afflicted with chronic diabetic nephropathy." Kubersampath relates to the use of a morphogen to treat inflammation. There is no discussion in Kubersampath of the use of a morphogen for treating chronic renal failure or chronic diabetic nephropathy, as conceded by the Examiner. However, it appears that the Examiner is relying on an alleged teaching in Kubersampath regarding the ability of OP1 to inhibit adherence of polymorphonuclear neutrophils as providing a motivation for combining the cited references. Applicants respectfully disagree and submit that the Examiner has not provided a sufficient rationale for why one skilled in the art, at the time of applicants' invention, would have been motivated to combine the references, let alone why such combination would have rendered obvious the claimed invention.

It is well known that inflammation is associated with many diseases and conditions. However, inflammation is not necessarily a marker for a any particular inflammation-associated disease (such as chronic renal failure and chronic diabetic nephropathy) because inflammation is

associated many other diseases and conditions too. There is nothing in any of the cited references or from what was known at the time of the invention, to suggest that one skilled in the art would reasonably expected to have been able to use a morphogen to treat chronic renal failure and chronic diabetic nephropathy. One skilled in the art would have been just as likely to use any other anti-inflammatory, such as ibuprofen, based on what was known at the time. But not every anti-inflammatory can treat chronic renal failure and chronic diabetic nephropathy. Applicants respectfully remind the Examiner that the standard is not "obvious to try." Rather the standard is "reasonable expectation of success." The Examiner has not provided any basis for why one skilled in the art would have had any reasonable expectation of success that a morphogen could treat chronic renal failure and chronic diabetic nephropathy. The Examiner is using impermissible hindsight in using the teachings of applicants' specification to combine the cited references. Accordingly, applicants contend that the Examiner has not established a prima facie case of obviousness.

Rejection under 35 U.S.C. §112, first paragraph

The Examiner rejected claims 1-4, 6, 10, 12, 15-17, 24, 28, 32 and 52-55 under 35 U.S.C. §112, first paragraph as containing subject matter allegedly not in the specification so as to reasonably convey to one skilled in the art that the inventor had possession of the claimed invention. In particular, the Examiner pointed out the term "wherein said mammal is not a kidney transplant recipient."

In response, applicants respectfully traverse the Examiner's above rejection. Nevertheless, applicants without conceding the correctness of the Examiner's position but to expedite prosecution of the subject application have herein amended the claims such that they no longer recite "wherein said mammal is not a kidney transplant recipient." Applicants contend that this amendment obviates the above rejection and respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Rejection under 35 U.S.C. §112, second paragraph

The Examiner rejected claim 17 under 35 U.S.C. §112, second paragraph as being indefinite for allegedly failing to particularly point out and distinctly claim the subject matter of

the invention. The Examiner stated that the term "50% of a number" is indefinite because it is unclear what number is intended and therefore, the metes and bounds are not clearly set forth.

In response, applicants respectfully traverse the Examiner's above rejection. Nevertheless, applicants without conceding the correctness of the Examiner's position but to expedite prosecution of the subject application have herein amended the claim such that it no longer recites "50% of a number." Applicants contend that this amendment obviates the above rejection and respectfully request that the Examiner reconsider and withdraw this ground of rejection.

Claim Objections:

The Examiner objected to claims 3 and 12, contending that BMP11 does not further limit an amino acid sequence having at least 70% amino acid sequence homology with amino acids 330-431 of SEQ ID NO:1.

In response, applicants without conceding the correctness of the Examiner's position but to expedite prosecution of the subject application have herein amended the claims. Applicants contend that this amendment obviates the above objection and respectfully request that the Examiner reconsider and withdraw this ground of objection.

In view of the above, each of the presently pending claims in this application is believed to be in immediate condition for allowance. Accordingly, the Examiner is respectfully requested to withdraw the outstanding rejections and objections of the claims and to pass this application to issue.

The Applicants believe that no fee is due. The Commissioner is hereby authorized to ~~charge any deficiency in the fees filed, asserted to be filed or which should have been filed~~ herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 18-1945, under Order No. PBLI-P08-004.

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Respectfully submitted,

By 

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